

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent of:

Ravi UPASANI et al.

Patent No. 7,652,006 B2

Issued: January 26, 2010

For: **SUBSTITUTED 1(2H)-
PHTHALAZINONES AND
PHARMACEUTICAL
COMPOSITIONS THEREOF**

Confirmation No. 5165

Art Unit: 1624

Examiner: Cecilia M. JAISLE

Atty. Docket: 1483.0340003/JMC

**Request for Reconsideration of Patent Term Adjustment
Under 37 C.F.R. § 1.705**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Mail Stop Patent Ext.

Sir:

Pursuant to 37 C.F.R. § 1.705(d), Patentees submit a Request for Reconsideration of Patent Term Adjustment in the captioned patent within two months of the date the patent issued. This Request is provided in view of the January 7, 2010 decision by the United States Court of Appeals for the Federal Circuit in *Wyeth v. Kappos*, No. 2009-1120, slip op. (Fed. Cir. Jan. 7, 2010), attached.

Statement of the Facts:

Patentee hereby requests that the Patent Term Adjustment for the captioned patent to be corrected to allow an addition of 671 days to the current Patent Term Adjustment of 1021 days, the total Patent Term Adjustment being 1692 days.

The U.S. Patent and Trademark Office (PTO) mailed a Notice of Allowance and Fee(s) Due on September 23, 2009. This Notice contained a determination of Patent Term Adjustment under 35 U.S.C. § 154(b), which incorrectly indicated that the Patent Term Adjustment (PTA) to the date of the Notice of Allowance and Fee(s) Due was 847 days. According to the information currently recorded in the PTO's

Patent Application Information Retrieval (PAIR) system, to the date of the Notice of Allowance and Fee(s) due, the Applicant delay was 64 days (37 C.F.R. §§ 1.704(b), 1.704(c), and 1.703(f)) and the PTO delay was 911 days.

On November 30, 2009, Patentee timely submitted the Issue Fee which was verified in the PAIR system on the same date.

On January 26, 2010, the PTO issued the above-captioned patent ("the '006 patent") indicating that the term of this patent is extended or adjusted under 35 U.S.C. § 154(b) by 1021 days. According to the information currently recorded in the PAIR system, the PTA of 1021 days is calculated as follows: the PTO delay of 1085 days (37 C.F.R. § 1.702(b)) reduced by the Applicant delay of 64 days (37 C.F.R. §§ 1.704(b), 1.704(c), and 1.703(f)).

The information currently recorded in the PAIR system incorrectly indicates that a delay of 1085 days is the total delay that has been caused by the PTO. Patentee agrees that a delay of 1085 days has been caused by the PTO by issuing the '006 patent 1085 days after the date that is three years after the date on which the application was filed under 35 U.S.C. § 111(a) (February 6, 2007). 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b). Accordingly, Patentee is entitled to a PTA of 1021 days (*i.e.*, 1085 days reduced by 64 days). 37 C.F.R. § 1.703(f).

In addition to the PTA of 1021 days discussed above, under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.702(a), Patentee is entitled to an adjustment of the patent term of the '006 patent of 671 days (911 days - 240 days), which is the number of days attributable to PTO examination delay. *See Wyeth v. Kappos*, No. 2009-1120, slip op. (Fed. Cir. Jan. 7, 2010).

Under 37 C.F.R. § 1.703(f), the total PTA is adjusted to account for overlap between periods of delay. Pursuant to 35 U.S.C. § 154(b)(2)(A), "to the extent that

periods of delay . . . overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed." In *Wyeth v. Kappos*, the court indicated that for purposes of 35 U.S.C. § 154(b)(2)(A), a period of delay due to the PTO's failure to issue a patent within three years does not begin until after three years from filing an application. Accordingly, Patentee is entitled to a PTA which is a sum of 1021 days caused by PTO's failure to issue the '198 patent within 3 years and 671 days (911 days - 240 days) caused by PTO examination delay.

The additional PTO delay of 911 days was caused by the failure to issue an action within 14 months of the filing date (887 days) and by the failure to issue an action within 4 months of the filing date of a reply (24 days) as correctly indicated in the PAIR system. The 911 days was reduced by the number of days which overlap with the 1021 days discussed above (240 days). The 671 days of PTO Examination delay is calculated as follows:

a) The information currently recorded in the PAIR system correctly indicates that a delay of 887 days was caused by the failure to issue an action within 14 months of the filing date of under 35 U.S.C. § 111(a) (February 6, 2004), which is the period starting on April 7, 2005 (the day after 14 months from the filing date of the application) and ending on September 10, 2007 (the date of mailing a restriction requirement) (37 C.F.R. § 1.703(a)(1)); and

b) The information currently recorded in the PAIR system correctly indicates that a delay of 24 days was caused by the failure to issue an action within 4 months of the filing date of a reply (April 30, 2009), which is the period starting on August 31, 2009 (the day after 4 months from the filing date a reply) and ending on September

23, 2009 (the date of mailing of the Notice of Allowance and Fees Due) (37 C.F.R. § 1.703(a)(2)); and

c) Pursuant to 37 C.F.R. § 1.703(f), the delay of 911 days (887 days + 24 days) is reduced by 240 days (216 days + 24 days), *i.e.*, the number of days accounting for a first period (216 days) starting on February 7, 2007 (the day after 3 years from application's filing date of February 6, 2004) and ending on September 10, 2007 (the mailing date of a restriction requirement), and a second period (24 days) starting on August 31, 2009 (the day after 4 months from the filing date a reply) and ending on September 23, 2009 (the date of mailing of the Notice of Allowance and Fees Due), which is the number of days that overlap with the delay of 1021 days discussed above. Thus, the 911 days is reduced by the 240 days which overlap with the 1021 day period discussed above, to arrive at an additional PTO Examination delay of 671 days (911 days - 240 days).

In view of above, Patentee is entitled to a Patent Term Adjustment of a total of 1692 days (*i.e.*, 1021 days + 671 days). 37 C.F.R. § 1.703(f).

The above-captioned patent is not subject to a terminal disclaimer. 37 C.F.R. § 1.705(b)(2)(iii).

In addition, there were no circumstances during the prosecution of the application that constitute a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth in 37 C.F.R. § 1.704(c) other than the delay of 64 days in the PAIR system, which is the sum of 1) 61 days caused by the failure to respond to the final Office Action mailed August 12, 2008 within three months (37 C.F.R. § 1.704(b)); and 2) 3 days caused by the failure to respond to the non-final Office Action mailed January 27, 2009 within three months (37 C.F.R. § 1.704(b)).

It is respectfully submitted that issues raised in this Request could not have been raised in an application for Patent Term Adjustment under 37 C.F.R. § 1.705(b).


In accordance with 37 C.F.R. § 1.705(b)(1), the fee set forth in 37 C.F.R. § 1.18(e) is provided in our accompanying Credit Card Payment Form PTO-2038. It is not believed that additional fees are required beyond those that may otherwise be provided in documents accompanying this paper. However, if additional fees are required, the U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

If it is believed, for any reason, that personal communication will expedite consideration of this Request, please do not hesitate to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Request is respectfully requested.

Respectfully submitted,

~~STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.~~



John M. Covert
Attorney for Patentee
Registration No. 38,759

Date: Feb. 5, 2010

JMC/CBF:jls
1100 New York Avenue, N.W.
Suite 800
Washington, D.C. 20005-3934
(202) 371-2600

1074366_1.DOC